



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,821	06/15/1999	REBECCA S. LEVINE	MICR0154	4582

27792 7590 12/31/2002

MICROSOFT CORPORATION
LAW OFFICES OF RONALD M. ANDERSON
600 108TH AVENUE N.E., SUITE 507
BELLEVUE, WA 98004

EXAMINER

PAULA, CESAR B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,821

Applicant(s)

LEVINE ET AL.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 10/11/2002.

This action is made Final.

2. Claims 1-33 are pending in the case. Claims 1, 18, and 24 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 9-10, 16, 18, 21, 23-24, 27, 29-30, and 32-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol et al, hereinafter Sobol (Pat. # 5,907,665, 5/25/99), and further in view of Hawes (Pat. # 6,094,662, 7/25/00, filed on 4/30/98).

Regarding independent claim 1, Sobol discloses the acquisition, and insertion of a scanned image, with the aid of an *active* scanner, into a document(s) using a document creation application. The scanner being in communication with the document creating application (col.2, lines 1-35, col.4,L.1-67).

Furthermore, Sobol fails to explicitly disclose: *inserting data representing said image....all without saving said data in other than a temporary buffer*. However, Hawes teaches the insertion of an image, and storage of the image in a cache or temporary buffer (c.1,L.40-67,

Art Unit: 2178

col.2, lines 52-67, col.4, lines 54-col.5, line 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Hawes, because Hawes teaches about the efficient storage of images.

Regarding claim 2, which depends on claim 1, Sobol discloses the scanning and importing an image into a document (col.4, lines 1-67). Sobol fails to explicitly disclose: *creating a list of all the image source devices in communication with the computer or select the image source device*. However, Hawes teaches a client with an OS for communicating with a server, and for viewing images (col.3, lines 26-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have created the list, because Sobol teaches a general purpose computer (those well known in the art to have operating systems which list the devices the computer is in communication with) for scanning images into documents (col.3, line 64-col.4, line 67).

Claim 3 is directed towards a method for implementing the steps found in claim 1, and therefore is similarly rejected.

Regarding claim 4, which depends on claim 1, Sobol discloses the selection of a specific portion of an image detecting the edges, and cropping them to comply with the user's selection (col.4, lines 21-67).

Regarding claim 5, which depends on claim 1, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18).

Claim 6 is directed towards a method for implementing the steps found in claim 5, and therefore is similarly rejected.

Regarding claim 9, which depends on claim 1, Sobol discloses the prescanning, and scanning of an image using a scanner which negotiates with a software when importing the scanned image to a document (col.4, lines 12-67).

Regarding claim 10, which depends on claim 9, Sobol discloses the selection of a specific portion of an image detecting the edges based on the application program and the capabilities of the scanner, and cropping the selected edges to comply with the user's selection (col.4, lines 21-67).

Claim 16 is directed towards a computer readable medium for storing the steps found in claim 1, and therefore is similarly rejected.

Regarding independent claim 18, Sobol discloses the scanning of images into a document. The various *images* are scanned and stored in the scanner and then imported into the document (col. 1, L. 12-67, col.4, lines 11-67, and col. 6,L.1-67). Sobol fails to explicitly disclose: *selection scheme for selecting a plurality of the stored multiple images for insertion into the document*. However, Hawes teaches the selection and insertion of images into a web page (col.1,L.40-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Hawes, because Hawes teaches the saving of time by caching images (col.2, lines 44-67).

In addition, Sobol discloses the compression of image(s) before inserting in a document (col.4, lines 37-col.5, line 18).

Regarding claim 21, which depends on claim 18, Sobol discloses the scanning of images into a document (col.2,lines 1-67, and col.4, lines 1-67). Sobol fails to explicitly disclose: *images are inserted into a presentation document as a plurality of individual slides..* However, it would

Art Unit: 2178

have been obvious to a person of ordinary skill in the art at the time of the invention to have used the images in a presentation as slides, because Sobol teaches above insertion of images into presentation documents, (powerpoint a very wellknown presentation application for presenting image in a slide format).

Claims 23-24, 27, 29-30, and 32-33 are directed towards a system for implementing the steps found in claims 1, 1, 21, 1, 1, and 4-5 respectively, and therefore are similarly rejected.

5. Claims 7-8, 19, 22, 25, and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, and further in view of Mastering Photoshop 5 for the Web, hereinafter Photoshop (1998, pp.1-10).

Regarding claim 7, which depends on claim 6, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). Sobol fails to explicitly disclose: *enhancement criterion is a contrast level of the image that is adjusted to enhance a brightness*. However, Photoshop teaches the altering of an image contrast/brightness (p.8,L.1-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Photoshop, because Photoshop teaches above the increasing of legibility of a textual document.

Regarding claim 8, which depends on claim 6, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). Sobol fails to explicitly disclose: *enhancement criterion is a color level of the image...based on a gamma correction algorithm*. However, Photoshop teaches the altering of an image color based on a gamma correction algorithm (p.2,L.14-20). It would have been obvious to a person of ordinary skill in

the art at the time of the invention to have combined the teachings of Sobol, and Photoshop, because Photoshop teaches above the customization of an image to be compatible with the colors of a specific computer platform.

Regarding claim 19, which depends on claim 18, Sobol discloses the scanning of images into a document(s) (col.4, lines 1-67). Sobol fails to explicitly disclose: *the application program is a word processing application, and the plurality of images are inserted into the document as a plurality of tiled images*. However, Photoshop teaches the creation of graphics using a tiling technique (p.4,L.14-p.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, Hawes, and Photoshop because Photoshop teaches above the use of tiled images as a web page background.

Claim 22 is directed towards a method for implementing the steps found in claim 7, and therefore is similarly rejected.

Claim 25 is directed towards a system for implementing the steps found in claim 19, and therefore is similarly rejected.

Claim 31 is directed towards a system for implementing the steps found in claim 7, and therefore is similarly rejected.

6. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, further in view of Photoshop, and further in view of Troubleshooting and configuring the Windows NT/95 Registry, Clayton Johnson, hereinafter Johnson (1997, pp.1-2).

Regarding claim 11, which depends on claim 9, Sobol discloses the selection of a specific portion of an image detecting the edges based on the application program and the capabilities of

Art Unit: 2178

the scanner, and cropping the selected edges to comply with the user's selection (col.4, lines 21-67). Sobol fails to explicitly disclose: *a set of capabilities are associated with the image source devices..and are stored in an operating system registry*. However, Johnson teaches the settings and capabilities of hardware being stored in a computer's Windows registry (p.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Johnson, because Johnson teaches above storing hardware information in a registry to enable an operating system to control and run those devices.

7. Claims 12-13, 15, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, and further in view of IBM ADF Color Scanner user's guide, hereinafter ADF (7/1995, pp.14-22, and fig.1-16).

Regarding claim 12, which depends on claim 1, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). Sobol fails to explicitly disclose: *determining whether the image source device that is active is able to perform an automatic image scan*. However, ADF teaches the setting or determination whether a device can automatically sending the image to a document associated with an application program (Fig.2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and ADF, because ADF teaches above the saving of time by organizing jobs into actions.

Regarding claim 13, which depends on claim 12, Sobol discloses the scanning of an image having X, Y resolution as set by a user selecting the portion of the image to be scanned (col.4, lines 37-col.5, line 18).

Moreover, Sobol discloses the prescanning, and confirming the X, Y resolution of an image (col.4, lines 37-col.5, line 18). Sobol fails to explicitly disclose: *confirming that the user interface of said source device can be bypassed*. However, ADF teaches the setting or determination whether a device can automatically sending the image to a document associated with an application program and bypassing the user interface while scanning the image (Fig.2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and ADF, because ADF teaches above the saving of time by organizing jobs into actions.

Claims 15, 17 are directed towards a computer readable medium for storing the steps found in claims 12, and 1, and therefore are similarly rejected.

8. Claim 14 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, and further in view of ADF, and further in view of Arakawa (Pat.#5,845,076, 12/1/98).

Regarding claim 14, which depends on claim 12, Sobol discloses the scanning of images into a document (col.4, lines 11-67). Sobol fails to explicitly disclose: *setting an error flag*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Arakawa, because Hawes teaches above a scheme to discover the scanning status.

Moreover, Sobol fails to explicitly teach *attempting to perform an automatic image scan*. However, ADF teaches the setting or determination whether a device can automatically sending the image to a document associated with an application program (Fig.2). It would have been

obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and ADF, because ADF teaches above the saving of time by organizing jobs into actions.

Furthermore, Sobol discloses the scanning of images into a document (col.4, lines 11-67). Sobol fails to explicitly disclose: *clearing the error flag if the automatic scan is successful, and evaluating the error flag..if the error flag has not been cleared*. However, Arakawa teaches the setting of an error flag to indicate whether there was an error in the scanning process, and therefore the scanning cannot be completed (col.10,L.34-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Arakawa, because Hawes teaches above a scheme to discover the scanning status.

9. Claims 20, and 26 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, further in view of Hearn et al, hereinafter Hearn (Pat.# 6,154,756, 11/28/00, filed on 7/1/96).

Regarding claim 20, which depends on claim 18, Sobol discloses the selection of a specific portion of an image detecting the edges based on the application program and the capabilities of the scanner, and cropping the selected edges to comply with the user's selection (col.4, lines 21-67). Sobol fails to explicitly disclose: *the plurality of inserted images are inserted into the spreadsheet document as a plurality of cascaded images*. However, Hearn teaches combining, and nesting different data with each other, such as graphics nesting within a spreadsheet (col.3, lines 1-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Hearn, because Hearn teaches above combining different data into a single document.

Claim 26 is directed towards a system for implementing the steps found in claim 20, and therefore is similarly rejected.

10. Claim 28 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Sobol, in view of Hawes, and further in view of TWAIN Specification v. 1.8(10/22/98 as disclosed by Applicants).

Regarding claim 28, which depends on claim 24, Sobol discloses the acquisition, and insertion of a scanned image, with the aid of an active scanner, into a document(s) (col.2, lines 1-35). Sobol fails to explicitly disclose: *the source manager module complies with the TWAIN communication specification*. However, Twain teaches the introduction of TWAIN standard for the interconnection of peripheral devices (p.1-1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Twain, because Twain teaches above the need for consistency in the control of hardware devices.

Response to Arguments

11. Applicant's arguments filed 10/11/02 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Hawes does not disclose or suggest inserting image data without saving the data, as claimed by applicants" p.4,L.1-3) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant

is not claiming that the image data is not being saved, but rather that image is not saved in "other than a temporary buffer" p.4,L.9-10.

The Applicant submits that there is no suggestion to combine Sobol and Hawes (p.4,L.20-25). The Examiner disagrees, because Hawes teaches the embedding of images into web pages (c.1, 40-67, c.2,L.14-67, c.4,L.1-c.5,L.67). Sobol teaches the acquisition of images, such as the images to be input into the Hawes system (c.2,L.1-35, c.4,L.1-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and Hawes, because Hawes teaches about the efficient storage of images, such as the images scanned in Sobol's teaching.

The Applicant states that neither Sobol nor Hawes teach the selection of images to be inserted into a document (p.5,L.6-26). The Examiner disagrees, because Sobol teaches the scanning of pictures, photos, documents, etc, and selecting those images by a user interface for insertion into a document being created by an application program, such as a web editing software as suggested by Hawes, although the rejection Hawes teaches the embedding of images into web pages (c.4, 1-67). Hawes teaches the embedding of multiple images, such as the images scanned by Sobol, into web pages being created by an author (c.1, 40-67).

Regarding claims 7-8, 19, 22, 25, and 31, the Applicant states that none would be motivated to consider the teachings of Sobol to perform any image enhancement on a black and white image (p.6,L.12-30). The Examiner disagrees, because, although it is true that Sobol teaches the compressing of the image(s), Sobol also teaches that if any editing of the image is warranted, that the image would be decompressed into greyscale (c.4,L.40-45). Photoshop teaches the adjustment of an image to increase legibility of text (p.8,L.1-28). It would have been

obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, Hawes, and, Photoshop, because Photoshop teaches above the enhancing, and increasing of legibility of overlaid text of an image which would be inserted in a document viewed by a user, such as the document taught by Sobol above.

Regarding claims 12-13, 15, and 17, the Applicant notes that neither Sobol, nor ADF teach the automatic scanning of image(s) without requiring an user to select image capture parameters (p.7,L.12-30). The Examiner disagrees, because, Sobol discloses the compression of an image before inserting in a document (col.4, lines 37-col.5, line 18). Sobol fails to explicitly disclose: *determining whether the image source device that is active is able to perform an automatic image scan*. However, ADF teaches the setting or determination whether a device can automatically sending the image to a document associated with a predefined application program, so that an user doesn't have to adjust image capture parameters, whenever scanning images (Fig.2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol, and ADF, because ADF teaches above the saving of time by organizing jobs into actions.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ratnakar et al. (Pat. # 6,421,468).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)

- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

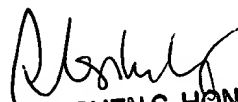
Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “**PROPOSED**” or “**DRAFT**”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

12/18/02


STEPHEN S. HONG
PRIMARY EXAMINER